

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JURGEN SCHWAB

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Appeal No. 1997-2908  
Application 08/347,201<sup>1</sup>

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ON BRIEF

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Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 5, 7-11, 14 and 20, all the claims

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<sup>1</sup> Application for patent filed November 21, 1994. According to the appellant, the application is a continuation of Application 07/865,501, filed April 9, 1992, now abandoned.

Appeal No. 97-2908  
Application 08/347,201

currently pending in the application.

By way of background, this is the second appeal of the presently disclosed subject matter. In Appeal No. 94-3699 in parent application SN 07/865,501, a merits panel of this Board affirmed the examiner's rejections of the appealed claims. Familiarity with the decision in the prior appeal is presumed.

Appellant's invention pertains to a container having a sealing member for sealing the opening of the container (claim 14), and a container seal *per se* (claims 5, 7-11 and 20). Of particular interest to appellant is the provision of a seal having an incision below a puncture area of the seal, wherein the incision extends only partially through the material beneath the puncture area. Independent claims 5 and 20 are illustrative of the subject matter in issue and read as follows:

5. A container seal which can be punctured for repeated liquid transfer to and from a container by means of a hollow needle, comprising:

an elastic sealing member having a top surface and a bottom surface and a puncture area on the top surface, the sealing member including only one incision therein, the incision positioned below the puncture area and extending from

Appeal No. 97-2908  
Application 08/347,201

the bottom surface through at least 75% but less than 100% of the thickness of the sealing member to define a layer between the incision and the puncture area which is capable of being punctured by a hollow needle to facilitate liquid transfer from a container, the layer consisting of rubber.

20. A container seal which can be punctured for repeated liquid transfer to and from a container by means of a hollow needle, comprising:

an elastic sealing member having a top surface and a bottom surface and a puncture area on the top surface, the sealing member including only one incision therein, the incision positioned below the puncture area and extending from the bottom surface through at least 75% but less than 100% of the thickness of the sealing member to define a layer between the incision and the puncture area which is capable of being punctured by a hollow needle to facilitate liquid transfer from a container and is substantially resealable after the needle is withdrawn from the container.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

1937	Monnier	2,099,370	Nov. 16,
1967	Nicko	3,343,699	Sept. 26,
1974	Zackheim	3,823,840	Jul. 16,
Apr. 10, 1990	Tatsumi et al	4,915,243	
1944	Freeman	558,998	Jan. 31,
	(British)		

Appeal No. 97-2908  
Application 08/347,201

The following rejections under 35 U.S.C. § 103 are before us for review:

(a) claim 5, 7, 14 and 20, unpatentable over Zackheim in view of either Freeman or Nicko;

(b) claims 8-10, unpatentable over Zackheim in view of either Freeman or Nicko, and further in view of Tatsumi; and

(c) claim 11, unpatentable over Zackheim in view of either Freeman or Nicko, and further in view of Monnier.

The rejections are explained in the examiner's answer (Paper No. 40, mailed March, 17, 1997).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 35, filed January 13, 1997) and the reply brief (Paper No. 41, filed May 12, 1997).

Zackheim, the examiner's primary reference in each of the standing § 103 rejections, discloses a prepunctured closure for a container comprising a flat member 24 preferably made of an elastomeric material such as rubber, an overlying barrier layer 26 advantageously made of a flexible, impermeable and tearable material such as aluminum foil (column 2, lines 54-

66), and a cap 28 having a tear tab 34 positioned over the barrier layer and flat member. The cap is crimped over a bead 22 on the mouth of the container to make a tight seal protecting the contents of the container. The flat member 24 includes a preformed slit 38 extending therethrough from one side to the other. The slit does not extend through the barrier layer 26. When it is desired to access the liquid contents of the container, the tear tab 34 and an underlying portion of the barrier layer are removed (see

Figures 6 and 7), and a blunt tipped plastic cannula 48 is inserted through the preformed slit in the flat member to allow for drawing off a quantity of the container's contents (see Figure 8). When the cannula is withdrawn, the slit reseals itself insuring that any remaining contents of the container is not contaminated by the outer atmosphere (column 3, lines 19-23).

Appeal No. 97-2908  
Application 08/347,201

Considering first the examiner's § 103 rejection of claims 5, 7, 14 and 20 as being unpatentable over Zackheim in view of either Freeman or Nicko, the examiner tacitly admits that Zackheim does not meet the requirement of independent claims 5 and 14 calling for an elastic member having an incision below a puncture area, wherein the incision extends *only partially through* the member to define a layer between the incision and the puncture area, *and wherein the layer consists only of rubber*. The examiner also tacitly admits that Zackheim does not meet the requirement of independent claim 20 calling for an elastic member having an incision below a puncture area, wherein the incision extends *only partially through* the member to define a layer

between the incision and the puncture area, *and wherein the layer is substantially resealable after the needle is withdrawn from the container*.

Freeman, the first of the examiner's secondary references, relates to stoppers "adapted to be readily pierced by hypodermic syringes" (page 2, lines 18-20). Freeman teaches in Figure 9 a stopper 12 fitting into the neck of the container, the stopper having a top diaphragm 19 extending over an open cavity with an indication or target ring 22 for showing the piercing area (page 3, lines 53-56). Nicko, the other of the examiner's secondary references, pertains to a closure 10 comprising a combination cap and tapping plug for bottles, cans, kegs or other containers. The tapping plug 22 of Nicko's closure comprises a stopper portion 38 which fits within the spout 12 of a container and a diaphragm or web 50 which is adapted to be pierced by a tapping device 42. Below the diaphragm, the plug is formed with a cylindrical opening or bore 52 through which the tapping device is inserted into the container after the diaphragm has been pierced (column 2, lines 50-56).

Based on the teachings of Freeman or Nicko, it is the examiner's position that

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Zackheim's sealing member 24 with a thin, unpunctured layer of sealing [material] (i.e., rubber) above slit 38 by stopping slit 38 short of the upper surface of the sealing member . . . because it would have obviated the need for separate barrier layer 26. [Answer, page 4.]

In responding to appellant's argument in the brief, the examiner further explains on page 6 of the answer that

it would have been obvious to an artisan at the time the invention was made to eliminate Zackheim's aluminum foil layer 26 in favor of an uncut layer of material at the top of sealing element 24, as suggested by either Nicko or Freeman. Whether the uncut layer overlies "an open cavity" as in Nicko and Freeman, or a slit, as in Zackheim, is immaterial to the question of obviousness.

Assuming for the sake of argument that Nicko is analogous prior art with respect to appellant's invention,<sup>2</sup> we will not sustain this rejection. We view the examiner's consideration of the teachings of the applied references to be based on the use of impermissible hindsight. Here, in an attempt to justify the

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<sup>2</sup>Appellant argues on pages 14 and 15 of the brief that Nicko constitutes non-analogous art.



proposed modification of Zackheim, the examiner has inappropriately devised a correspondence between (1) the slit 38 in Zackheim's flat member 24 and the underlying open cavities or chambers of Freeman and Nicko, and between (2) the aluminum foil barrier layer 26 of Zackheim and the diaphragms of Freeman and Nicko. One of ordinary skill in the art, in our view, simply would not have so interpreted the applied prior art *at the time of appellant's invention* (i.e., without the benefit of having first seen appellant's invention). In this regard, we view the examiner's theory as to what the ordinarily skilled artisan would have gleaned from a reading of the applied references to be flawed because of both structural and functional differences between the various structures of the references. The structural differences between the slit 38 and aluminum foil barrier layer 26 of Zackheim on the one hand and the open chambers and overlying elastomeric diaphragms of Freeman and Nicko on the other hand are readily apparent. Functionally, Zackheim's slit 38 is constructed to *reseal itself* when the cannula 48 is withdrawn,

whereas the open cavities or chambers of Freeman and

Nicko clearly were never intended to function in this manner. Further, the barrier layer 26 of Zackheim is, in effect, physically and bodily *removed* from the container prior to insertion of the cannula (see Figure 7), whereas the diaphragms of Freeman and Nicko are *pierced* by the cannula. From our perspective, at best, Freeman and Nicko would have suggested to one of ordinary skill in the art that the flat member 24 of Zackheim might somehow be modified to provide an annular portion on the lower surface thereof that extends into the neck of the container to hold it in place. However, such a modification clearly would not result in the subject matter called for in the independent claims on appeal.

In light of the foregoing, we will not sustain the standing rejection of claims claim 5, 7, 14 and 20 as being unpatentable over Zackheim in view of Freeman or Nicko.

Concerning the rejection of claims 8-10 as being

Appeal No. 97-2908  
Application 08/347,201

unpatentable over Zackheim in view of Freeman or Nicko and further in view of Tatsumi, and the rejection of claim 11 as being unpatentable over Zackheim in view of Freeman or Nicko and further in view of Monnier, we have carefully reviewed the

Tatsumi and Monnier references additionally relied upon by the examiner but find nothing therein that makes up for the deficiencies of Zackheim, Freeman and/or Nicko discussed above. Accordingly, we also will not sustain the standing rejections of these dependent claims.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER )  
Administrative Patent Judge )  
)

Appeal No. 97-2908  
Application 08/347,201

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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
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	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
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